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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,603	04/02/2004	Martin N. Wybourne	1505-68152	9819

24197 7590 04/27/2006  
KLARQUIST SPARKMAN, LLP  
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EXAMINER

SHIBUYA, MARK LANCE

ART UNIT PAPER NUMBER

1639

DATE MAILED: 04/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/816,603	<b>Applicant(s)</b> WYBOURNE ET AL.	
	<b>Examiner</b> Mark L. Shibuya	<b>Art Unit</b> 1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2006.
- 2a) ☐ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-13 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Supplemental Requirement for Election of Species***

1. Applicant's election of the species of thiol ligand that is mercaptoundecanoic acid; and election of a substrate that comprises silicon nitride, in the reply filed on 2/13/2006, is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Applicant stated that claims 1-7 and 9-13 read on the species of mercaptoundecanoic acid and that claims 1-13 read on the species of silicon nitride. The examiner respectfully disagrees and submits that amended claim 1, now reciting the language "11-mercaptounde**conic** acid" [emphasis added], apparently is drawn to a different species. Furthermore, because claims 9 and 10 depend from non-elected claim 8, claims 9 and 10 do not read on the elected species of mercaptoundecanoic acid.
3. The examiner respectfully notes that the elected species, "mercaptoundecanoic acid", does *not* appear to be recited or disclosed in the instant application as filed. On the other hand, the term "mecaptounde**conic**" does appear in the specification as filed.

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4. The examiner further respectfully notes that U.S. Patent No. 6,872,971, over which claims 1-3 were rejected in the previous Office action, for obviousness-type double patenting, does disclose both the terms "mercaptoundecanoic acid" and "mercaptoundeconic". The '971 Patent refers to "mercaptoundecanoic acid" once, in the context of Figure 15 of the patent. However, it is noted that the instant application does not contain or disclose a Figure 15.

5. Therefore, in the interest of compact prosecution and a proper search of the elected species and claims, the examiner has respectfully required this supplemental restriction requirement in order to clarify and resolve whether "mercaptoundecanoic acid", (as found in amended claim 1), and the elected species of "11-mercaptoundeconic acid", (as found in newly added claim 11), are, in fact, different species. Applicant must explain whether and how these compounds are the same or obvious variants of each other or altogether different species of thiol ligands.


6. The examiner, in order to understand applicant's election of species, also requests that the applicant provide the complete and final molecular structures of "mercaptoundecanoic acid" and "11-mercaptoundeconic acid". These structural formulae should specify each bond and atom of "mercaptoundecanoic acid" and "11-mercaptoundeconic acid".

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark L. Shibuya whose telephone number is (571) 272-0806. The examiner can normally be reached on M-F, 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Mark L. Shibuya  
Examiner  
Art Unit 1639

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